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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/510,087	02/22/2000	Paul A. Smith	EVS-P-99-017	2705

7590 08/13/2002

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EXAMINER
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WALCZAK, DAVID J

ART UNIT	PAPER NUMBER
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3751

DATE MAILED: 08/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/510,087

Applicant(s)

SMITH, PAUL A.

Examiner

David J. Walczak

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-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11-20 is/are pending in the application.
- 4a) Of the above claim(s) 12, 13 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11 and 14-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Specification***

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The new limitation "substantially covers" does not have antecedent basis in the specification.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 6-9, 14-17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fischer in view of Martin. In regard to claims 1, 3, 4, 6-9, 15 and 16, Fischer discloses a marking device having a barrel defined between first and second ends wherein the first end has a tip capable of producing a mark and a sheath in the form of a flat article which wraps around the marking device and "substantially covers" the device (i.e., as the sheath fully surrounds a large portion of the marking device, and in as much as the Applicant has defined "substantially covers" in the specification, the sheath is considered to "substantially cover" the marking device) wherein a "clamp" (the stitching, in as much as the Applicant has defined the term "clamp", the stitching used to

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clamp the ends of the sheath together, and thereby clamp the sheath to the marking device is considered to be a clamp) which removably secures the flat article around the barrel of the marking device. Although the Fischer reference does not disclose the use of an end cap and chain, attention is directed to the Martin reference, which discloses an end cap 15 removably attached on the second end of a marking device wherein the end cap is interchangeable between a plurality of marking devices (see lines 82-85) and a connecting lead in the form of a chain 14 having first and second ends wherein the first end extends from the end cap in order to enable the marking device to be conveniently stored. It is further noted that although the Martin reference does not disclose that the chain is removably connected to the end cap, the Examiner takes official notice that chains are commonly employed with removable connectors at the ends thereof in order to enable the chain to be removably connected to an element (attention is directed to page 8, lines 5-7 of the Applicant's response filed 9/21/01 wherein the Applicant admits that such connectors are commonly known). Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include such an end cap and chain onto the Fisher device in order to enable the device to be conveniently stored. In regard to claim 2, the sheath is cylindrically shaped with an aperture therethrough. In regard to claim 14, there must exist some "tool" which attaches the clamp to the article. In regard to claims 17 and 19, the method as claimed is inherent in the usage of the device discussed supra.

Claims 5, 11 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fischer in view of Martin as applied to claims 1, 9 and 17 above, and further in

view of the Applicant's disclosure. Although the sheath in the Fischer device is not disclosed as having an antibacterial substance thereon, attention is directed to page 7, line 17 of the Applicant's disclosure, which discloses that such substances are commonly used to coat surfaces in order to render the surface sanitary. Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to coat the sheath in the Fischer device with an antibacterial coating in order to render the device sanitary.

### ***Response to Arguments***

Applicant's arguments filed 9/21/01 have been fully considered but they are not persuasive. The Applicant's arguments with regard to claims 15 and 16 are moot due to the new grounds of rejection. Regarding the Applicant's contention that there is no suggestion to combine the Martin and Fischer references, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, one of ordinary skill in the art, after reviewing both of these references (which both disclose marking instruments) would readily recognize that the Fischer marking device can obviously be supported by the chain in the Martin device.

In response to Applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Walczak whose telephone number is 703-308-0608. The examiner can normally be reached on Mon-Thurs, 6:30- 5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg L. Huson can be reached on 703-308-2580. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0861.



David J. Walczak  
Primary Examiner  
Art Unit 3751

DJW  
August 13, 2002